

PRELIMINARY REMARKS

Claims 1 to 4, 10 to 14 and 16 to 26 as set forth in Appendix I of this paper are herewith presented for further prosecution. Relative to the version of claims previously before the Examiner, Claim 9 has been canceled, Claims 1, 10, 11 and 16 have been amended, and Claim 26 has been added, as indicated in the listing of the claims.

More specifically, applicants have further specified the inorganic UV filter (B) as “*at least one micronized, hydrophobicized zinc oxide.*”<sup>2)</sup> Claims 10, 11 and 16 have been revised accordingly. New Claim 26 further requires that the inorganic UV filter (B) consist of the “*at least one micronized, hydrophobicized zinc oxide.*” No new matter has been added.

The Examiner rejected Claims 1 to 4 and 9 to 19 under 35 U.S.C. §103(a) as being unpatentable in light of the teaching of *Dieing et al.* (EP 0 893 117) when taken in view of the disclosure of *Dupuis et al.* (US 5,553,630), or when taken in view of the disclosure of *Eteve et al.* (US 5,643,557). It is respectfully solicited that the Examiner favorably reconsider her position in light of the foregoing changes in the claims and the following remarks.

The United States Supreme Court recently reiterated: “*Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.*”<sup>3)</sup> Noting that the analysis under 35 U.S.C. §103 “*need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ,*”<sup>4)</sup> the Court cautioned, however, that “*rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*”<sup>5)</sup> The Court also emphasized the need “*to determine whether there was an apparent reason to combine known elements in the fashion claimed by the patent at issue.*”<sup>6)</sup>

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2) Cf., e.g., Claim 9.

3) *Graham v. John Deere*, 383 U.S. 1, at 17 – 18, 148 USPQ 459 (1966). Cf. *KSR Int'l v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007), Slip op. at 2.

4) *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, \_\_\_, 82 USPQ2d 1385, 1397 (2007).

5) *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. at \_\_\_, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

6) *KSR Int'l v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (2007), Slip op. at 14.

To establish a prima facie case of obviousness it is, therefore, essential that there be some motivation or suggestion to make the claimed invention in light of the prior art teachings.<sup>7)</sup> “[A] proper analysis under §103 requires, *inter alia*, consideration of ... whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process.”<sup>8)</sup> The patentability of a claim to a specific compound or subgenus embraced by a prior art genus should be analyzed no differently than any other claim for purposes of 35 U.S.C. §103. “The section 103 requirement of unobviousness is no different in chemical cases than with respect to other categories of patentable inventions.”<sup>9)</sup> A determination of patentability under 35 U.S.C. §103 should be made upon the facts of the particular case in view of the totality of the circumstances,<sup>10)</sup> and the use of per se rules is improper for determining whether claimed subject matter would have been obvious under 35 U.S.C. §103.<sup>11)</sup> In particular, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness.<sup>12)</sup> Again, it is necessary to determine whether there was an apparent reason to select and combine the known elements in the fashion claimed.

It is respectfully urged that the teaching of *Dieing et al.* when taken in view of either one or both the disclosures of *Dupuis et al.* and *Eteve et al.*, fails to provide an apparent reason to combine the particular elements of applicants’ invention in the fashion claimed.

The Examiner acknowledged *inter alia* that *Dieing et al.* failed to teach the particular inorganic UV filter component (B) of applicants’ claims, and applied the disclosures of *Dupuis et al.* and *Eteve et al.* for showing the use of certain metal oxide pigments in hair-care cosmetic compositions.

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- 7) See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) (“[T]he mere possibility that one of the esters or the active methylene group-containing compounds ... could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious “unless the prior art suggested the desirability of [such a] modification” or replacement.”) (quoting *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).
- 8) *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).
- 9) *In re Papesch*, 315 F.2d 381, 385, 137 USPQ 43, 47 (CCPA 1963).
- 10) See, e.g., *In re Dillon*, 919 F.2d 688, 692-93, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990) (in banc).
- 11) See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995); *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994).
- 12) *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (“The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious.”); *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has “decline[d] to extract from Merck [ & Co. v. Biocraft Laboratories Inc., 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that ... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it.”). See also *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1215 (Fed. Cir. 1995).

As noted in the foregoing, applicants' claims require that the inorganic UV filter (B) be "*at least one micronized, hydrophobicized zinc oxide.*" It is respectfully urged that neither the disclosure of *Dupuis et al.* nor the disclosure of *Eteve et al.*, taken alone or taken in combination with one another, can be deemed to provide an apparent reason to select and combine the elements of applicants' invention in the fashion claimed.

The disclosure of *Dupuis et al.* specifically pertains to compositions for protecting hair against degradation caused by light. To this end, the authors employ metal oxide nanopigments of titanium, zinc, cerium or zirconium,<sup>13)</sup> which may be coated or uncoated.<sup>14)</sup> However, it is evident from, for example, the statement that "*Coated or uncoated titanium oxide pigments are particularly preferred for use in the present invention,*"<sup>15)</sup> that the presence or absence of a coating is not deemed to be pertinent when the pigment is selected. The foregoing statement, as well as the information provided in the section spanning col. 1, indicated line 47, to col. 2, indicated line 20, of the reference also conveys that the nature of the coating such as hydrophilic or hydrophobic properties thereof, is of no concern. The Examiner will appreciate that, for example, the coated pigments MT-100SA<sup>16)</sup> and MT-150W<sup>17)</sup> which are enumerated by *Dupuis et al.* have hydrophobic surface properties.<sup>18)</sup> A person of ordinary skill who contemplated the disclosure of *Dupuis et al.*, therefore, had no apparent reason to specifically select a micronized, hydrophobicized zinc oxide from the uncoated and coated metal oxides which are mentioned in the reference.

Essentially the same rationale applies where the disclosure of *Eteve et al.* is concerned. Similar to the disclosure of *Dupuis et al.*, *Eteve et al.* refer to nanopigments which may be coated or uncoated,<sup>19)</sup> and point out that coated or uncoated titanium oxide nanopigments are particularly preferred,<sup>20)</sup> which conveys that the presence or absence of a coating is not deemed to be pertinent. Also similar to the disclosure of *Dupuis et al.*, *Eteve et al.* provide information in the section spanning col. 2, indicated line 53, to col. 3, indicated line 36, of the reference which conveys that the nature of the coating such as hydrophilic or hydrophobic properties thereof, is of no concern.<sup>21)</sup> Accordingly, a person of ordinary skill who contemplated the disclosure of *Eteve et al.*, therefore,

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13) E.g., col. 1, indicated lines 30 to 38, of *US 5,553,630*.

14) E.g., col. 1, indicated line 47, of *US 5,553,630*.

15) E.g., col. 2, indicated lines 37 and 38, of *US 5,553,630*.

16) Cf. col. 1, indicated lines 62 and 62, of *US 5,553,630*.

17) Cf. col. 2, indicated lines 19 and 20, of *US 5,553,630*.

18) Data sheets enclosed.

19) Cf. col. 2, indicated line 52, of *US 5,643,557*.

20) Cf. col. 3, indicated lines 64 and 65, of *US 5,643,557*.

21) The pigments MT-100SA and MT-150W are mentioned by *Eteve et al.* in col. 3, indicated lines 4-5 and 34-36, of *US 5,643,557*.

also had no apparent reason to specifically select a micronized, hydrophobicized zinc oxide from the uncoated and coated metal oxides which are mentioned in the reference.

As noted in the foregoing, the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness.<sup>12)</sup> Again, it is necessary to determine whether there was an apparent reason to select and combine the known elements in the fashion claimed. Neither the disclosure of *Dupuis et al.* nor the disclosure of *Eteve et al.* can be deemed to provide an apparent reason to select a micronized, hydrophobicized zinc oxide from the host of uncoated and coated metal oxide pigments which are described in the secondary references. As such, the teaching of *Dieing et al.* taken in view of either one or both of the disclosures is not deemed to establish that the subject matter of applicants' claims was prima facie obvious at the time the invention was made.

Favorable reconsideration of the Examiner's position and withdrawal of the respective rejections is respectfully solicited.